



Attention: Mail Stop AF  
Docket No.: 1293.1989

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jae-bum JANG

Serial No. 10/734,134

Group Art Unit: 2627

Confirmation No. 9205

Filed: December 15, 2003

Examiner: Tan X. Dinh

For: METHOD OF ELIMINATING HOME-IN NOISE IN OPTICAL DISC DRIVE BY USING  
VARIABLE STEP COUNTER

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the Final rejection mailed December 26, 2007 finally rejecting claims 1-3 and 10-13 of the above-identified application.

The request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached pages.

Respectfully submitted,

STAAS & HALSEY LLP

Dated: May 2, 2008

By: [Signature]

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## **Reasons for Request for Review**

### **Status of claims**

Claims 1-17 are pending in the application. Claims 4-9 are objected to but are indicated as allowable if rewritten in independent form. Independent claims 1 and 10 and dependent claims 2, 3 11, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of an Abstract of Korean Publication No. P1991-0008507 by Lee ("Lee Abstract").

Applicant asserts the rejections are improper for at least the reasons provided below:

### **Reason Number 1**

The final rejection under 35 U.S.C. § 103(a) is improper because it is based on alleged teachings that are not present in Lee Abstract. Specifically, the Office Action contends that Lee Abstract teaches all of the features recited in independent claim 1. Applicant submits that the Office Action fails to set forth a prima facie case of unpatentability.

As provided in the MPEP, the burden is on the USPTO to set forth a prima facie case of unpatentability. MPEP 2106 IV B.

By way of example and not limitation, independent claim 1 recites at least:

“...calculating a number of tracks from the current position of the optical pickup to a home position and converting the number of tracks into a step counter value to obtain a step counter value of the home position; and

moving the optical pickup to the home position through an access operation,

wherein the step counter value of the home position is an integer varying depending on the position of the optical pickup when power is applied.”

In the final rejection, the Office Action merely recites the above claim language and asserts that it is taught by Lee Abstract. No rationale is provided. Moreover, the Office Action fails to specifically set forth how the above-claimed features are described in Lee Abstract. For example, Lee Abstract fails to even mention a “step counter” or a “home position.”

In an interview conducted on March 6, 2008, the Examiner indicated that one or more of the recited features were inherently recited by Lee Abstract. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP 2112 IV citing *Ex parte Levy*, 17 USPQ2d 1461, 1464

(Bd. Pat. App. & Inter. 1990) (emphasis in original). Applicant asserts that the Final Office Actions fails to provide the objective evidence and technical reasoning necessary to support such a conclusion of inherency.

Accordingly, the Office has failed to set forth a prima facie case of unpatentability, and therefore claim 1 is submitted to be patentable over Lee Abstract, absent evidence of unpatentability. Since similar features recited by independent claim 10, with potentially differing scope and breadth, are not suggested or disclosed by Lee Abstract, the rejection should be withdrawn and claim 10 also allowed. Claims 2, 3 11, 12 and 13, which depend from and include all of the features of independent claims 1 and 10 respectively, should be allowable for at least the same reasons as claims 1 and 10.

## **Reason Number 2**

In each of the first Office Action mailed February 27, 2007, the Final Office Action mailed December 26, 2007, and the Advisory Action mailed April 8, 2008, the Examiner rejected the independent claims based on the Lee Abstract.

In response, Applicant asserted the rejection based on the Lee Abstract is improper according to MPEP § 706.02, part II, which states:

Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

Further, "if a document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection" (MPEP 706.02, section II (emphasis added)).

Moreover, in response to the final Office Action, Applicant requested a translation of the Lee Abstract in any future office action relying on the same and requested that support for the rejection be provided from the specification of Lee itself, rather than from the abstract. The Examiner has not provided a translation of Lee, nor, consequently, has the Examiner provided rejections based solely on the Lee specification.

### **Reason Number 3**

The final rejection of claim 3 under 35 U.S.C. § 103(a) is improper because the Examiner takes official notice of facts without citing a prior art reference.

By way of example and not limitation, dependent claim 3 recites at least:

"The method of claim 1, wherein, when a disc is not loaded into the optical disc drive, the optical pickup does not move to the home position but stays at the current position when power is applied to the optical disc drive."

In the final Office Action, the Examiner states:

"it would have been obvious to keep the optical pick-up at current position in LEE's optical disc driver when power is applied to optical disc drive since by moving optical pick-up without loading, optical disc will create noise during" [sic].

The Applicant specifically points out the following errors in the final Office Action.

First, the Office Action uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

Any facts so noticed should . . . serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this feature is unique to the claimed invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the assertion. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

### **Reason Number 4**

The final rejection of claim 2 under 35 U.S.C. § 103(a) is improper because the Examiner relies upon the theory of inherency for the rejection without providing a basis in fact. In the rejection, the final Office Action states:

“As to claim 2, the home position at 00:02:00 is inherent in every optical disc recording medium.”

“In relying upon the theory of inherency, one must provide a basis in fact and/or technical reasoning reasonably to support a determination that the allegedly inherent characteristic *necessarily* will be present if the teachings of the prior art are followed.” *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). The Final Office Actions fails to provide the objective evidence and technical reasoning necessary to support such a conclusion of inherency.

For all of the above reasons, Applicant asserts the rejections of claims 1-3 and 10-13 under 35 U.S.C. § 103(a) are deficient.